

REMARKS

This paper is in response to the Office Action mailed on March 15, 2004.

Claims 31, 36, 45, 47, and 57 are amended and no claims are canceled or added; as a result, claims 31-57 are now pending in this application.

Double Patenting Rejection

Claims 31-57 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-31 and 33-36 of co-pending of Application No. 09/751,329. Applicant does not admit to the grounds of this double patenting rejection. Applicant reserves the right to submit arguments or a terminal disclaimer at when, or if, this rejection becomes an actual provisional double patenting rejection.

§112 Rejection of the Claims

Claims 31-57 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action asserts that these claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverses this assertion. For the sake of brevity, only the independent claims will be addressed to match the rejection.

With respect to claims 31 and 36, the Office Action asserts that “the specification does not enable one skilled in the art how to make the wet-wipe have increased thickness after stretching. Applicant respectfully submits that the specification does provide enablement commensurate with the scope of claims 31 and 36. First, the Office Action at page 3, in the last paragraph admits, “[T]he specification . . . enables that stretching and recovery causes an increased thickness in the wet-wipe.” Second, Applicant draws the examiner’s attention to page 10, lines 12 – 20 wherein various features of the present inventive subject matter are discussed relating to arrangement of wet-wipe elements. The examiner’s attention is further drawn to Figure 1 and the description thereof found at page 13, line 19 – page 20, line 22. Therein, various elements of a process according example embodiments of the present inventive subject matter are provided. These portions of the figures and specification, among others found

throughout the specification, enable a person of ordinary skill in the art to make and use the invention commensurate with the scope of claims 31 and 36.

With respect to claim 47, Applicant respectfully asserts that the claim is fully supported throughout the specification. Nevertheless, claim 47 is amended. This amendment clarifies the inventive subject matter of the claim and is fully supported by the specification.

With respect to claim 57, the Office Action admits that the specification enable that stretching and recovery cause an increased thickness in the wet-wipe. However, the Office Action asserts that the specification fails to enable how the stretching and recovery provide an increased thickness. First, Applicant believes this rejection is unclear in view of the admission and requests clarification should the rejection be maintained. Second, Applicant respectfully traverses this rejection. Applicant draws the examiner's attention to page 10, lines 12 – 20 wherein various features of the present inventive subject matter are discussed relating to arrangement of wet-wipe elements. The examiner's attention is further drawn to Figure 1 and the description thereof found at page 13, line 19 – page 20, line 22. Therein, various elements of a process according example embodiments of the present inventive subject matter are provided. These portions of the figures and specification, among others found throughout the specification, enable a person of ordinary skill in the art to make and use the invention commensurate with the scope of claim 57.

Claims 47-51 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description. The Office Action asserts that these claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully submits that the clarifying amendment to claim 47 overcomes this rejection.

Claims 31-35 and 47-51 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

With regard to claims 31-35, the Office Action alleges that the claims are indefinite as failing to set forth specific compositions as to what the wet-wipe is made of. Applicant

respectfully disagrees regarding the indefiniteness of the quoted passage. The Board of Patent Appeals and Interferences has stated:

In rejecting a claim under the second paragraph of 35 U.S.C. § 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte* Wu, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989)(citing *In re* Moore, 439 F.2d 1232, 169 USPQ 236 (C.C.P.A. 1971); *In re* Hammack, 427 F.2d 1378, 166 USPQ 204 (C.C.P.A. 1970)).

The M.P.E.P. adopts this line of reasoning, stating that:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (1) The content of the particular application disclosure;
- (2) The teachings of the prior art; and
- (3) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *M.P.E.P.* § 2173.02.

Applicant respectfully submits that the claim language in question, when analyzed in light of the content of the application disclosure, is not indefinite. Throughout the specification, examples are provided of various compositions of the wet-wipe. More specifically, various compositions are set forth in the definitions section of the specification and throughout the detailed description portion. Applicant respectfully submits that claims 31 – 35, when viewed in light of the application disclosure, are not vague nor indefinite.

Further, Applicant respectfully traverses the functional language grounds for rejection and points out that functional language is specifically authorized by *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); MPEP § 2173.05(g).

Thus, Applicant respectfully submits that claims 31-35 are in compliance with 35 U.S.C. § 112, second paragraph.

With regard to claims 47-51, Applicant respectfully submits that the clarifying amendment to claim 47 overcomes this rejection.

Thus, applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 112 rejections.

§102 and § 103 Rejections of the Claims

Claims 31-41, 43, 44, 52, 54 and 57 were rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jackson et al. (U.S. Patent No. 4,741,944). Claims 55 and 56 were rejected under 35 USC § 103(a) as being unpatentable over Jackson et al. in view of Lange et al. (U.S. Patent No. 6,429,261). Claims 31-37, 40-41, 43-47 and 54-57 were rejected under 35 USC § 103(a) as being unpatentable over Wideman et al. (U.S. Patent No. 4,606,964) in view of Jackson et al. Claims 38, 39 and 48-53 were rejected under 35 USC § 103(a) as being unpatentable over Wideman et al. in view of Jackson et al. and further in view Buczwinski et al (U.S. Patent No. 5,785,179). Claim 42 was rejected under 35 USC § 103(a) as being unpatentable over Jackson et al. in view of Wright (U.S. Patent No. 5,385,775). Claim 42 was rejected under 35 USC § 103(a) as being unpatentable over Wideman in view of Jackson et al. and further in view of Wright.

All of the above rejections are based at least in part on Jackson. Applicant respectfully submits that reliance on Jackson to reject the claims under either 35 U.S.C. §§ 102 or 103 is misplaced. Accordingly, the rejections must be withdrawn.

“Anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). The Office Action admits that Jackson does not explicitly teach the features of the thickness after stretching would be greater than the thickness before stretching. Further, Jackson fails to disclose any natural fibers as set forth in the amended independent claims 31, 36, 47, and 57. Thus, a prima facie case of anticipation has not been made. Reconsideration and withdrawal of the anticipation rejection are requested.

With regards to the § 103(a) rejections of the claims, applicant respectfully submits that the claims are allowable over the combinations of references for the reasons set forth in previous responses and renews those arguments by reference. Applicant further submits that the claims, as presently amended are allowable at least because all of the independent claims include natural fibers. In contrast, Jackson, which is used in all of the § 103(a) rejections, teaches away from natural fibers.

For example, Jackson recites:

“The advent of formation of plastic material such as plastic sheets, films and nonwoven webs by extrusion processes such as, for example, slot film extrusion, blown bubble film extrusion, meltblowing of nonwoven webs and spinbonding of nonwoven webs allowed a wide variety of products to be manufactured so inexpensively that they could be view as disposable, as opposed to reusable.” Col. 1, lines 14-21.

Jackson further provides:

“An interesting observation that has been made is that the effect of gravity on the liquid contained within the present wipes appears to be significantly less than its effect on prior wipes of cellulosic materials. That is, seepage of the liquid to the bottom of a stack of the present wipes is far less rapid than seepage which has been associated with cellulosic wipes. It has been hypothesized that the lower rate of seepage of the present wipe is due to the fact that the meltblown and/or spunbonded fibers of the present wipe are not subject to capillary collapse as is believed to be the case with cellulosic materials.” Col. 13, lines 9-20.

The Office Action in paragraph 12 points to Wideman as providing for the use of natural fibers. However, Jackson cannot be properly combined with Wideman because a person of ordinary skill in the art would be discourage from doing so. *See In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963). Thus, because Jackson teaches away from the use of natural fibers in the wet-wipes as set forth in amended independent claims 31, 36, 47, and 57, the claims are patentable in their amended form.

Claims 32-36, 37-46, and 48-56 depend, directly or indirectly, on amended independent claims 31, 36, and 47, and are patentable for the reasons argued above, plus the elements in the claims. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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16 Aug '04

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of August, 2004.

Gina M. Uphus

Name



Signature